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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/530,563	04/07/2005	Takao Hasegawa	040894-7216	8997
9629 7590 05/24/2007 MORGAN LEWIS & BOCKIUS LLP 1111 PENNSYLVANIA AVENUE NW WASHINGTON, DC 20004			EXAMINER REYNOLDS, STEVEN ALAN	
			ART UNIT 3728	PAPER NUMBER
			MAIL DATE 05/24/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/530,563

Applicant(s)

HASEGAWA ET AL.

Examiner

Steven Reynolds

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-12 and 14-27 is/are pending in the application.
- 4a) Of the above claim(s) 22-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-12 and 14-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to the reply filed on 4/24/2007, wherein claim 10 was amended and claim 13 were canceled. Claims 10-12 and 14-27 are pending. Claims 22-27 remain withdrawn from consideration.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

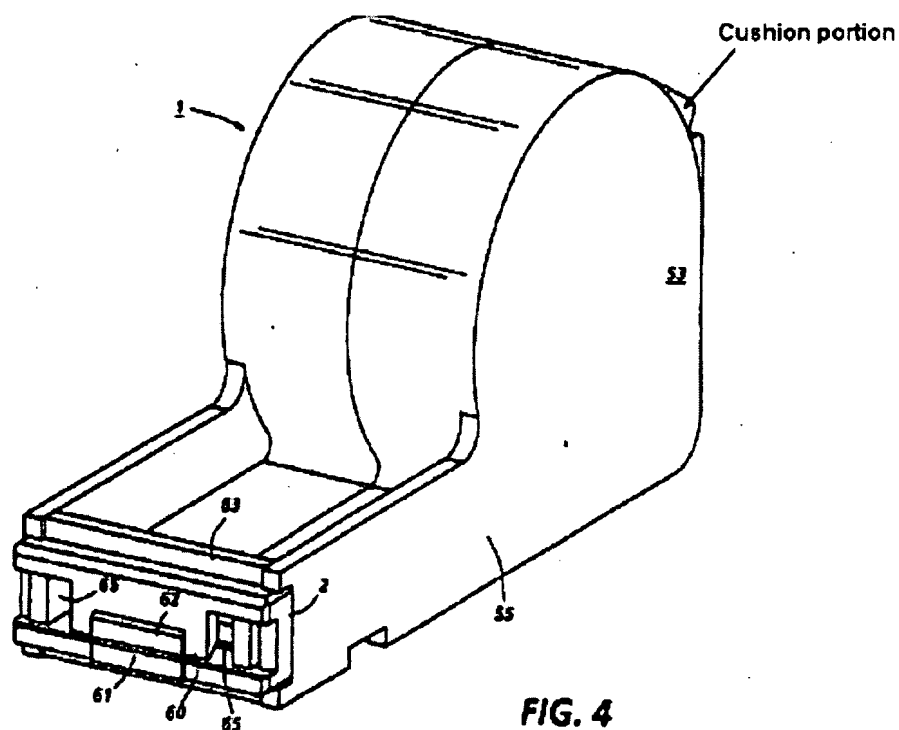
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 10, 11 and 14-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Logtens (US 5,273,199). Logtens discloses a staple case (1) that contains a roll staple (54) formed by connecting unformed staples in a roll shape comprising an opening (56), formed at a part of the staple case facing a circumferential surface of the roll staple (See Fig. 3 embodiment), through which a member (belt 14) for rotating the roll staple is brought into contact with the roll staple (See column 3, lines 47-52); a pull-out opening (slot 60) through which the roll staple is pulled out; a cushion

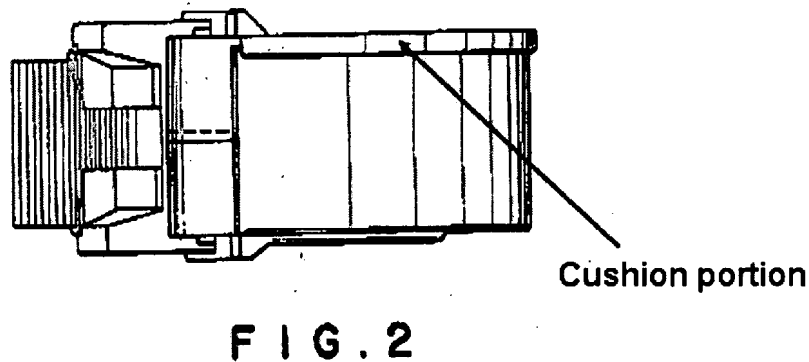
portion (protrusion extending from the back side of the case - See figure below); a portion for positioning in a containing chamber (the bottom surface of the staple case rests on ribs 51 of the containing chamber); and a guide portion for guiding the staple case to a containing chamber (sides of the staple case allow it to be slid between side frame members 11 of the containing chamber).



4. Claims 10-12, 14, 17 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Garfinkel (US 3,602,414). Garfinkel discloses a staple case that contains a roll staple (19) formed by connecting unformed staples in a roll shape comprising an opening (opening between forward extending portions 17 in Fig. 4 embodiment), formed at a part of the staple case facing a circumferential surface of the roll staple, through which a member for rotating the roll staple is capable of being brought into contact with

the roll staple; a pull-out opening through which the roll staple is pulled out (See Fig. 5 embodiment); a cushion portion (See figure below); a first case half (13) and a second case half (14); and a weak portion (hinge member 15) on a joint between the first case half and second case half.

Regarding claim 12, since no reference point for the orientation of the case is claimed, the case of Garfinkel can be oriented in a position where the pull-out opening is at a vertical center of a front face.



Regarding the intended use of the claimed invention "an opening....through which a member for rotating the roll staple is brought into contact with the roll staple", it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. If the prior art structure is capable of performing the intended use, then it meets the claim. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

5. Claims 10, 11 and 14-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Mochizuki (US 6,568,579). Mochizuki discloses a staple case (cartridge

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4) that contains a roll staple formed by connecting unformed staples in a roll shape comprising an opening (opening in lower portion of cartridge 4 wherein roller 23 is positioned – See Fig. 4 embodiment and Figure below), formed at a part of the staple case facing a circumferential surface of the roll staple, through which a member (roller 23) for rotating the roll staple is brought into contact with the roll staple (See column 5, lines 21-26); a pull-out opening (opening wherein staples S pass beneath plate 4 – See Fig. 4 embodiment) through which the roll staple is pulled out; a cushion portion (See figure below); a portion for positioning in a containing chamber (45 slides into 43 to position the cartridge into the containing chamber 2); a guide portion for guiding the staple case to a containing chamber (46 slides into 44 to guide the cartridge into the containing chamber 2); a first case half and a second case half (See Figure below); a first opening (opening wherein staples S pass beneath plate 4 – See Fig. 4 embodiment) through which the roll staple is pulled out; and a second opening (opening in lower portion of cartridge 4 wherein roller 23 is positioned – See Fig. 4 embodiment and Figure below) through which a member for rotating the roll staple is brought into contact with the roll staple, wherein the first opening is provided on the second case half, and the second opening is provided on the first case half (See Figure below); and a weak portion (hinge – See Figure below) on a joint between the first case half and the second case half.

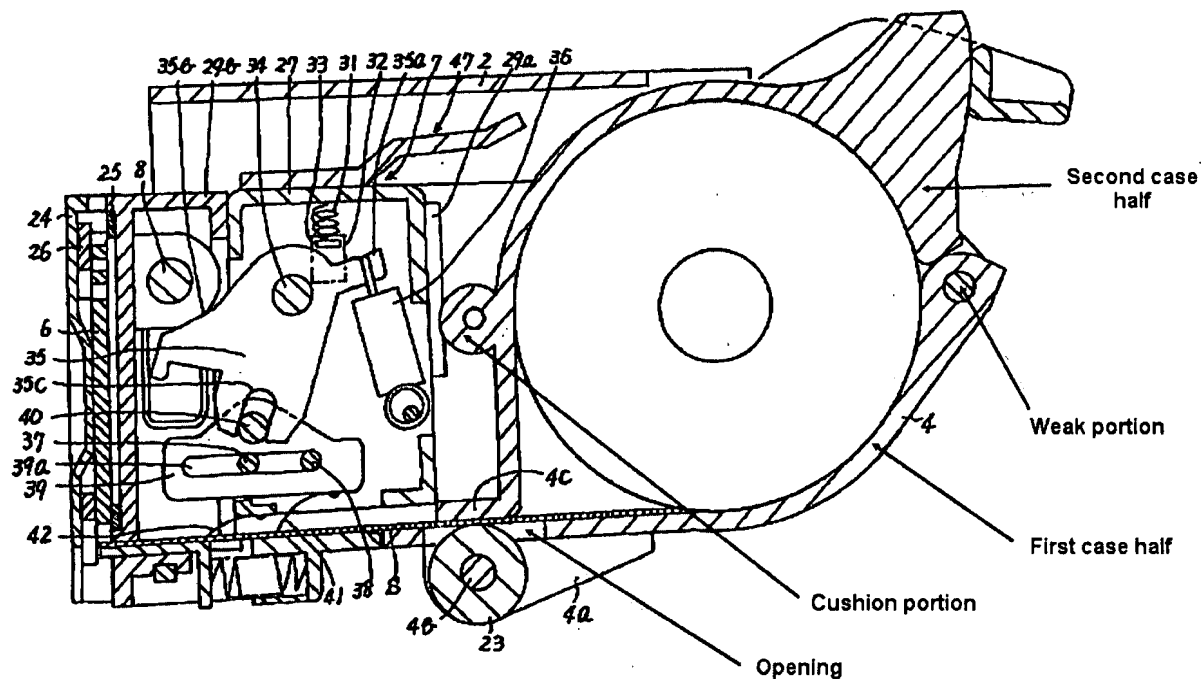


Fig. 4

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
8. Claims 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mochizuki (US 6,568,579) in view of Haramiishi (US 7,048,165). Mochizuki discloses an upper/front face (Second case half – See Figure above) and a bottom/back face (First case half – See Figure above) having a different shape to the upper face. Mochizuki discloses all the limitations of the claims except for the specifics of the markings on the staple case.

However, Haramiishi teaches a cartridge casing (24) comprising an arrow on the side face of the case for the purpose of indicating the direction in which the case is inserted into the stapler (See Fig. 7 embodiment). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the staple case of Mochizuki with the arrow marking on the side face as taught by Haramiishi in order to show the user the correct direction in which the staple case is to be inserted into the stapler.

Response to Arguments

9. Applicant's arguments filed 4/24/2007 have been fully considered but they are not persuasive. Contrary to applicant's argument that Logtens, Garfinkel and Mochizuki do not disclose an opening formed at part of the staple case facing a circumferential surface of the roll staple: the openings, as described above, meet the language of "facing a circumferential surface of the roll staple" since there is a direct view of a circumferential surface of the roll staple through the openings.

Regarding applicant's argument that Garfinkel does not disclose an opening through which a member for rotating the roll staple is brought into contact with the roll staple: a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. The opening, as described above, is capable of accommodating a member for rotating the roll staple.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Reynolds whose telephone number is (571)272-9959. The examiner can normally be reached on Monday-Friday 9:00am - 5:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571)272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SR

5/22/07



Mickey Yu
Supervisory Patent Examiner
Group 37C0